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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/737,325	12/14/2000	Stephen F. Bisbee	003670-063	9515

7590 08/26/2004

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EXAMINER

PYZOCHA, MICHAEL J

ART UNIT	PAPER NUMBER
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2137

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DATE MAILED: 08/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/737,325

Applicant(s)

BISBEE ET AL.

Examiner

Michael Pyzocha

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 December 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 December 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-25 are pending.

Priority

2. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 119 as follows:

An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence of the specification or in an application data sheet (37 CFR 1.78(a)(2) and (a)(5)). The specific reference to any prior nonprovisional application must include the relationship (i.e., continuation, divisional, or continuation-in-part) between the applications except when the reference is to a prior application of a CPA assigned the same application number.

Specification

3. The abstract of the disclosure is objected to because it is longer than the maximum of 150 words. Correction is required. See MPEP § 608.01(b).

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Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. Claims 1-3, 5-6, 9, 17, 20-22, 25 contain the trademark/trade name "e-original". Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe an object

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being transferred and, accordingly, the identification/description is indefinite.

For examination of prior art these claims will be considered without the trademark.

Claims 1-3, 5-6, 9-10, 13-20, 22-23, 25 contain the trademark/trade name "trusted custodial utility (TCU)". Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe an object being transferred and, accordingly, the identification/description is indefinite.

For examination of prior art these claims will take the TCU as a third-party file repository as described in the specification.

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7. Claim 7 recites the limitation "the wrapper" in line 1. There is insufficient antecedent basis for this limitation in the claim. The phrase "the wrapper" is undefined in the claim and claims it is dependant on. For examination of prior art "the wrapper" will be assumed to be as described in claim 6.

Any claims not specifically addressed are rejected by virtue of their dependencies.

Claim Rejections - 35 USC § 101

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-21, 25 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As per claim 1, the preamble has not been given patentable weight since (1) the claim body does not refer back to the preamble nor (2) does the preamble breath life and meaning into the claim. The claim is therefore directed to steps for establishing rules as in lines 9-17. These steps merely define steps to abstractly establish rules without limiting them to a practical application. Nothing in the claim language even requires the steps to be performed by a computer. The steps

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could be performed mentally or on paper. The claim is therefore not limited to a practical application within the technological arts.

As per claim 25, it is rejected for essentially the same reasons as claim 1.

Any claims not specifically addressed are rejected by virtue of their dependencies.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Graziano et al (U.S. 5,191,613) and further in view of Takaragi et al (U.S. 4,885,777).

As per claim 1, Graziano et al discloses a method of handling stored objects that have been created by signing information objects by submitting signed information objects to a trusted custodial utility (see column 14 lines 9-12 and lines

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37-41), validating the submitted signed information object (see column 14 lines 18-24), establishing a rule that establishes a least one type of object, establishing a rules that establishes at least one type of object as potential transferable records (see column 4 lines 44-63), establishing a rule that enables at least one selected user to access at least one selected type of object (see column 6 lines 47-56), establishing a rule the identifies at least one type of object required to conclude a deal (see column 4 lines 47-50), establishing a rule that controls transformation of a selected object into a transferable record (see column 5 line 66 through column 6 line 23).

Graziano et al fails to disclose the TCU applying a date-time stamp, digital signature and authentication certificate of the TCU to each information object.

However, Takaragi et al discloses the use of a date-time stamp, digital signature and authentication certificate (see column 7 lines 20-23).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to use the date-time stamp, digital signature and authentication certificate of Takaragi et al in the system of Graziano.

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Motivation to do so would have been to allow a user more time to determine if any of the authentication materials are invalid (see Takaragi et al (column 7 lines 23-44)).

As per claim 2, the modified Graziano et al and Takaragi et al system discloses that based on rules established by an owner of an object requiring execution as part of concluding the deal, the TCU notifies at least one participant in the deal when the object is received by the TCU (see Graziano column 14 lines 60-67).

As per claim 5, the modified Graziano et al and Takaragi et al system discloses the TCU receiving a request from a user to retrieve content of an object, checking the established rule associated with the type of object identified in the request to determine whether the user has been enabled to access the type of object identified in the request (see Graziano et al column 14 lines 12-28).

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Stefik (U.S. 5,715,403) discloses a system for controlling distribution and use of digital works, Wang et al (U.S. 5,490,217) discloses an automatic document handling system which files, retrieves, and

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verifies the documents, Vollert et al (U.S. 5,208,858) discloses the use of a central authentication server, Fischer (U.S. 5,001,752) discloses a time notarization method.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Pyzocha whose telephone number is (571) 272-3875. The examiner can normally be reached on 7:30am - 5:00pm first Fridays of the bi-week off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on (571) 272-3868. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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